

REMARKS

Summary of Office Action

Claims 1-40 were pending in the above-identified patent application.

The Examiner stated that applicants' Supplemental Information Disclosure Statement ("IDS"), as filed on April 25, 2002, fails to comply with 37 C.F.R. § 1.98(a)(2).

The Examiner rejected claims 1-40 under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner") in view of LaDue U.S. Patent No. 5,999,808 (hereinafter "LaDue").

Summary of Applicants' Reply to Office Action

New claims 41-71 have been added.

The Examiner's statement regarding the April 25, 2002 Supplemental IDS and claim rejections are respectfully traversed.

Supplemental Information Disclosure Statement

The Examiner stated that applicants' April 25, 2002 Supplemental IDS fails to comply with 37 C.F.R. § 1.98(a)(2),

which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed" (Office Action, page 2).

During a telephonic conversation on December 3, 2002, the Examiner informed the undersigned that the April 25, 2002 Supplemental IDS fails to comply with 37 C.F.R. § 1.98(a)(2) because the documents referred to in the Supplemental IDS were missing. During a follow-up telephonic conversation on December 4, 2002, the Examiner informed the undersigned that the documents referred to in the April 25, 2002 Supplemental IDS have not been found. The Examiner informed the undersigned that he will consider the U.S. patent documents referred to in the April 25, 2002 Supplemental IDS by accessing the U.S. Patent Office online database of U.S. patents and patent publications. However, because the U.S. Patent Office online database does not include foreign publications, the undersigned sent paper copies of the foreign publications to the Examiner on December 24, 2002. The Examiner informed the undersigned that the Examiner will consider the documents referred to in the April 25, 2003 Supplemental IDS and will send the

undersigned an initialed copy of the corresponding Form PTO-1449.

The Rejection Of Claims 1-40
Over Brenner In View Of LaDue
Under 35 U.S.C. § 103(a)

The Examiner rejected claims 1-40 under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of LaDue. The Examiner's rejection is respectfully traversed.

Applicants' invention, as defined by independent claims 1, 32, 35, 36, 37, and 40, is directed towards a method and system for interactive wagering on races with a cellular telephone.

The Examiner contends that Brenner and LaDue are analogous art because they are from a similar problem solving area of interactive wagering. Applicants respectfully traverse the Examiner's contention. LaDue teaches a method for transmitting application specific messages over cellular radio system control channels and switches. The application specific messages may be used for gaming or wagering. Generally speaking, Brenner refers to systems and methods for interactive off-track wagering. Brenner, however, as admitted by the Examiner, fails to refer to a cellular radio system.

Nevertheless, the Examiner contends that it would have been obvious to a person of ordinary skill in the art to combine "transmitting application specific messages over cellular radio system control channels and switches, for use in wireless gaming and wagering of LaDue with Brenner" (pages 3, 26, 29, 30, and 32 of the Office Action) (emphasis added). Contrary to the Examiner's contention, as described above, Brenner fails to refer to any cellular radio system to which LaDue's application specific message could be applied. Accordingly, applicants submit that it would not be obvious to combine LaDue with Brenner.

Furthermore, applicants submit that it would not even be technically possible to combine LaDue's application specific messages to Brenner's system because Brenner does not refer to a cellular radio system. In addition, the Examiner has failed to show how such a combination would be technically possible.

The Examiner states that the motivation for combining LaDue and Brenner "would have been to provide transmitting application specific messages over cellular radio system control channels and switches, for use in wireless gaming and wagering" (pages 3, 26, 29, 30, and 32 of the Office Action). This alleged motivation, however, is identical to the

Examiner's proposed combination. The Examiner is improperly using the resultant combination as the alleged motivation for making the combination.

Applicants respectfully submit that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art" (MPEP § 2143.01).

Applicants respectfully submit that the Examiner is merely making a broad conclusory statement, and fails to point to any objective teaching by either Brenner or LaDue that would lead one of ordinary skill in the art to combine the references. Such "[b]road conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence'" of a motivation to combine. In re Dembiczak, 50

U.S.P.Q.2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 U.S.P.Q.2d 1769 (Fed. Cir. 2000).

The Examiner has used applicants' own invention as a bridge between Brenner and LaDue. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak at 1617-1618. For this reason alone, the rejection of claims 1-40 must be withdrawn. Gambro Lundia AB v. Baxter Healthcare Corp., 52 U.S.P.Q.2d 1378, 1383 (Fed. Cir. 1997).

Dependent claims 2-31, 33, 34, 38, and 39 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Brenner in view of LaDue. Because applicants have demonstrated in the previous section that independent claims 1, 32, 35, 36, 37, and 40 are allowable, dependent claims 2-31, 33, 34, 38, and 39 are also allowable.

For at least the above reasons, applicants respectfully request that the rejection of claims 1-40 under 35 U.S.C. § 103(a) be withdrawn.

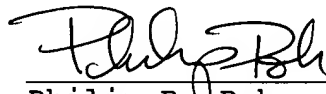
New Claims

New claims 41-71 have been added. New independent claim 41 is directed towards computer readable medium and is similar to independent claim 1. Therefore, new claim 41 is patentable for the same reasons that claim 1 is patentable.

Conclusion

The foregoing demonstrates that claims 1-71 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,



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